

Application Serial No. 10/699,919

Amendment Dated November 6, 2006 - Response to Office Action of August 4, 2006

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REMARKS/ARGUMENTS

By this paper, Applicant responds to the Office Action of August 4, 2006 and requests reconsideration of the application.

Claims 21-44 remain in this application. Claims 21, 27, 35 and 43 are independent.

Claim 21 has been amended to correct a typographical error. It is respectfully submitted that no new matter has been added by this amendment and that the amendment be entered.

C.F.R. § 1.116(b)(2).

I. Paragraph 1 of the Office Action - Claims 21, 35 and 43

Paragraph 1 of the Office Action suggests that claims 21, 35 and 43 may be indefinite under 35 U.S.C. 112, second paragraph. The Office Action is wrong, for two separate reasons.

A. The Office Action Applies an Incorrect Legal Test

First, the legal test applied for "definiteness" confuses several things that must be kept separate. The MPEP instructs that the reason given in the Office Action is an improper basis for raising a definiteness issue, and there is no reason to reject the use of broad, generic claim terms such as "rule indicator," "indicia" and the like:

2174 Relationship Between the Requirements of the First and Second Paragraphs of 35 U.S.C. 112

The requirements of the first and second paragraphs of 35 U.S.C. 112 are separate and distinct. If a description or the enabling disclosure of a specification is not commensurate in scope with the subject matter encompassed by a claim, that fact alone does not render the claim imprecise or indefinite or otherwise not in compliance with 35 U.S.C. 112, second paragraph...

2173.04 Breadth Is Not Indefiniteness

Breadth of a claim is not to be equated with indefiniteness. In re Miller, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph.

If the Examiner is aware of any statement of law that "indefiniteness" may be based on use of broad claim language instead of narrow specific "structure," Applicant requests a citation thereto. On the current state of the record, no § 112 ¶ 2 rejection exists: when an agency takes in action in violation of its own procedural manual, that action has no legal existence. *Vitarelli v. Seaton*, 359 U.S. 535, 545 (U.S. Sup. Ct. 1959) (action is "illegal and of no effect").

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B. The Office Action Overlooks Relevant Facts

Second, Applicant respectfully disagrees with the Office Action's statement that there is no support in the specification for the limitations "rule indicator," "information indicator" and "indicia that indicate". Support for these limitations may be found, for example, in paragraphs [0010] and [0021] of the specification as originally filed and original claim 9:

9. A game apparatus according to claim 1 wherein each game piece has a corresponding card that gives the player all the information regarding that game piece needed to play the game.

II. Paragraph 2 of the Office Action – Claims 35-40 and 42

Claim 35 recites as follows:

35. A game comprising:

a first sphere having a first value;

a second sphere having a second value; and

a rule indicator describing rules wherein the first value is compared to the second value when the first sphere contacts the second sphere to determine an outcome.

Gohlke does not anticipate claim 35 because it does not disclose the limitation where "the first value is compared to the second value when the first sphere contacts the second sphere to determine an outcome".

A. The Office Action is Inadequate to Raise Any Rejection Whatsoever

Paragraph 2 states that the basis for disregarding this claim limitation is that "meaning and information conveyed by the printed matter" is "not considered patentable." Paragraph 4 states that it is disregarded because it "has no definite structure." The Office Action cites no authority for either supposed rule of law.

It appears that the Examiner has confused two different legal principles – the "printed matter" exception under § 101 with the scope of a claim for § 102 purposes. Printed matter and instruction manuals must be given weight in an anticipation analysis, *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 403 (CCPA 1983):

Differences between an invention and the prior art cited against it cannot be ignored merely because those differences reside in the content of the printed matter. Under section 103, the board cannot dissect a claim, excise the printed matter from it, and declare the remaining portion of the mutilated claim to be unpatentable. The claim must be read as a whole.

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Paragraph 4 of the Office Action states that "Limitation 'rule indicator' has no definite structure and has no patentable weight as apparatus." Applicant is unaware that any such principle of patent law exists, except possibly in connection with a means-plus-function claim limitation -- which is not an issue here. The MPEP twice suggests that the principle of law employed in the Office Action is wrong:

2173.06 Prior Art Rejection of Claim Rejected as Indefinite

All words in a claim must be considered in judging the patentability of a claim against the prior art. *In re Wilson*, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970). The fact that terms may be indefinite does not make the claim obvious over the prior art. When the terms of a claim are considered to be indefinite, at least two approaches to the examination of an indefinite claim relative to the prior art are possible.

First, where the degree of uncertainty is not great, and where the claim is subject to more than one interpretation and at least one interpretation would render the claim unpatentable over the prior art, an appropriate course of action would be for the examiner to enter two rejections: (A) a rejection based on indefiniteness under 35 U.S.C. 112, second paragraph; and (B) a rejection over the prior art based on the interpretation of the claims which renders the prior art applicable. See, e.g., *Ex parte Ionescu*, 222 USPQ 537 (Bd. App. 1984). When making a rejection over prior art in these circumstances, it is important for the examiner to point out how the claim is being interpreted. Second, where there is a great deal of confusion and uncertainty as to the proper interpretation of the limitations of a claim, it would not be proper to reject such a claim on the basis of prior art. As stated in *In re Steele*, 305 F.2d 859, 134 USPQ 292 (CCPA 1962), a rejection under 35 U.S.C. 103 should not be based on considerable speculation about the meaning of terms employed in a claim or assumptions that must be made as to the scope of the claims.

The MPEP instructs that claim limitations are to be given their "broadest reasonable interpretation, not disregarded. Because the Office Action fails to take either of the two "possible" courses set forth in MPEP § 2173.06, no rejection exists.

If the Examiner is aware of any written statement of any such rule, Applicant requests a citation to such. Unless such authority is provided, the MPEP instructs that all claim limitations are to be given weight.

B. The Office Action Concedes that a Claim Limitation is Absent from Gohlke. Second, the Office Action makes no attempt to show where Gohlke discloses this limitation. The game of pool as referenced in Gohlke does not disclose, teach or suggest the comparing of values on pool balls that "contact" each other "to determine an outcome." Rather, Gohlke's scoring is based on other factors.

Because Gohlke does not anticipate independent claim 35, it cannot anticipate its dependent claims.

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III. Paragraphs 3 and 4 of the Office Action

Paragraphs 3 and 4 of the Office Action discuss claims 21-26, 27-34 and 41-44. Claim 27, which is representative, recites as follows:

27. A method of playing a game comprising the steps of:
- a) providing a plurality of spheres, with at least one sphere having a visible figure associated with it,
 - b) providing indicia associated with respective ones of the plurality of spheres;
 - c) providing a random number generator;
 - d) placing a first one of the plurality of spheres inside a defined playing field; and then
 - e) physically striking the first sphere inside the playing field with a second one of the plurality of spheres; and
 - f) using the random number generator in combination with the indicia associated with the first and second spheres to determine an outcome.

Claim 27 recites the limitation of "the rules specify an outcome that is determined using the random number generator and the at least one information indicator when two of the spheres come into contact with each other."

A. The Office Action Fails to Address the Claim Language

The Office Action paraphrases claim 27 as if it recited "using dice for determining outcome." The claim language "in combination with" is totally disregarded in the Office Action.

Because the Office Action fails to consider all claim limitations, it is too incomplete to raise any rejection whatsoever.

B. Neither Gohlke nor Chavarria Disclose "In Combination With"

Gohlke discloses a game that is played in two distinct, non-overlapping phases. Dice are used to move markers around the board. Then, in a separate phase, depending upon where the marker lands on the board, the players play a game of billiards or cards. These two steps are completely independent of each other in Gohlke: Gohlke's dice play no role in the outcome of the card game or billiards game, and Gohlke's billiards play no role in determining the outcome of the dice/board phase. Thus, Gohlke fails to disclose, teach or suggest that the dice and the numbers on the pool balls be used "in combination" to determine an outcome.

Chavarria discloses only a method of manufacturing pool balls, and never discusses any scoring method for any game played with his pool balls.

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As discussed above, Gohlke fails to disclose each and every limitation of claim 35, and Chavarria also fails to disclose these missing limitations. The Office Action makes no attempt to show where Gohlke or Chavarria discloses these limitations.

C. Claims 21 and 43

Claims 21 and 43 recite similar language and are patentable for similar reasons. For example, claim 21 recites the limitation "an outcome that is determined using the random number generator and the at least one information indicator when two of the spheres come into contact with each other." This claim language requires that the random number generator be used when the two spheres come into contact with each other, and not in two distinct phases.

Because Gohlke and Chavarria, either separately or in combination with each other, fail to disclose each and every limitation of independent claims 21, 27, 35 and 43, these claims, as well as their respective independent claims, are also patentable over Gohlke and Chavarria.

IV. Final Rejection is Premature

As noted above, each claim recites language that was improperly excluded from consideration. Any new explanation relating to that claim language will necessarily constitute a "new ground of rejection," which in turn will require withdrawal of finality. *In re Kumar*, 418 F.3d 1361, 1367, 76 USPQ2d 1048, 1051 (Fed. Cir. 2005) (any "additional explanation" that "had not previously been identified by the examiner or the Board" is a "new ground").

Applicant suggests that if the claims are not allowed, finality will have to be withdrawn.

For all of the above reasons, applicant respectfully observes that claims 21-44 are not rejected, and may now be allowed.

Respectfully submitted,

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